

AF/3629

COMBINED TRANSMITTAL OF APPEAL BRIEF TO THE BOARD OF PATENT
APPEALS AND INTERFERENCES & PETITION FOR EXTENSION OF TIME
UNDER 37 C.F.R. 1.136(a) (Late Entry)

Docket No.
PHD98-097 (16197)

In Re Application Of: Henning Maab, et al.

Serial No.
09/530,253

Filing Date
April 26, 2000

Examiner
Richard Woo

Group Art Unit
3629

Invention: ARRANGEMENT AND METHOD FOR LOCATING DATA CARRIERS

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AUG 15 2003

GROUP 3600

TO THE COMMISSIONER FOR PATENTS:

This is a combined Transmittal of Appeal Brief to the Board of Patent Appeals and Interferences and petition under the provisions of 37 CFR 1.136(a) to extend the period for filing an Appeal Brief.

Applicant(s) hereby request(s) an extension of time of (check desired time period):

☒ One month ☐ Two months ☐ Three months ☐ Four months ☐ Five months

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TOTAL FEE FOR APPEAL BRIEF AND EXTENSION OF TIME: \$430.00

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**COMBINED TRANSMITTAL OF APPEAL BRIEF TO THE BOARD OF PATENT
APPEALS AND INTERFERENCES & PETITION FOR EXTENSION OF TIME
UNDER 37 C.F.R. 1.136(a) (Large Entity)**

Docket No.
PHD98-097 (16197)

In Re Application Of: **Henning Maab, et al.**

AUG 11 2003

Serial No.
09/530,253

Filing Date
April 26, 2000


Examiner
Richard Woo

Group Art Unit
3629

Invention: **ARRANGEMENT AND METHOD FOR LOCATING DATA CARRIERS**

TO THE COMMISSIONER FOR PATENTS:

This combined Transmittal of Appeal Brief to the Board of Patent Appeals and Interferences and petition for extension of time under 37 CFR 1.136(a) is respectfully submitted by the undersigned:


Signature

Dated: August 7, 2003

Thomas Spinelli
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#12
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BRIEF ON APPEAL

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

#12
8.19.03
Walden

Applicant: Henning Maab, et al. Art Unit: 3629

Serial No.: 09/530,253

Examiner: Richard Woo

Filed: April 26, 2000

Docket: PHD98-097 (16197)

For: ARRANGEMENT AND
METHOD FOR LOCATING
DATA CARRIERS

Dated: August 7, 2003

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Sir:

I. INTRODUCTION

Pursuant to the provisions of 35 U.S.C. §§ 134 and 37 C.F.R. §§ 1.191 and 1.192, this paper is submitted as a brief setting forth the authorities and arguments upon which Appellants rely in support of the appeal from the Final Rejection of Claims 1-4 in the above-identified patent application on February 11, 2003.

II. REAL PARTY OF INTEREST

The real party of interest in the above-identified patent application is U.S. Philips Electronics.

III. RELATED APPEALS AND INTERFERENCES

Appellants respectfully submit that the present application is involved in no other appeal or interference besides the present Appeal.

IV. STATUS OF THE CLAIMS

The parent application, U.S. patent application Serial No. 09/530,253 was filed on April 26, 2000, originally included Claims 1-5. A sixth claim was added in a preliminary amendment filed concurrently with the application.

In an Official Action dated October 30, 2002, the Examiner rejected claims 1 and 2 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,550,551 to Alesio (hereinafter "Alesio"). Furthermore, the Examiner rejected claims 1-6 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,365,451 to Wang et al., (hereinafter "Wang"). Lastly, the Examiner rejected claims 3-6 under 35 U.S.C. § 103(a) as being unpatentable over Alesio.

In a Response under 37 C.F.R. § 1.111, filed January 27, 2003, independent claims 1 and 3 were amended to clarify their distinguishing features and to incorporate the features of original claims 5 and 6.

Specifically, Applicants argued that Alesio does not teach or suggest "area information is stored in an information unit which is remote from the at least one data carrier and can

be transmitted to the at least one data carrier" as is recited in claim 1 and "position data is allocated to an area in the information unit, and the boundaries of the area are transmitted to the data carrier" as is recited in claim 3. Applicants further argued that Wang does not teach or suggest "a third party interrogates the information unit for the location of a data carrier" as recited in claims 1 and 3, as amended.

In the Final Official Action, issued February 11, 2003, the Examiner rejected claims 1-4 under 35 U.S.C. § 103(a) as being unpatentable over Wang. Consequently, Claims 1-4 are the claims on appeal. A copy of the rejected claims is attached hereto in the Appendix.

V. STATUS OF THE AMENDMENTS

Appellants have not filed any amendments subsequent the issuance of the Final Rejection of February 11, 2003.

VI. SUMMARY OF THE INVENTION

The present invention relates to a locating system. The locating system has at least one data carrier located in an area and includes a position sensor, a transmitter and a receiver. The locating unit further has an information unit remote from the data carrier for storing area information and transmitting the area information to the data carrier. The

data carrier transmits its position to the information unit only in the case of initialization and movement of the data carrier from the area. Furthermore, a third party can interrogate the information unit for the position of the data carrier.

VII. THE APPEALED CLAIMS

Claims 1-4 are on appeal before the Board of Patent Appeals and Interferences, with Claims 1 and 3 being the independent claims. Independent Claim 1 is directed to a locating system comprising: at least one data carrier located in an area, the at least one data carrier including a position sensor, a transmitter and a receiver; an information unit which is remote from the at least one data carrier for storing area information and transmitting the area information to the at least one data carrier; wherein said at least one data carrier transmits its position to the information unit only in the case of initialization and movement of the at least one data carrier from the area and wherein a third party interrogates the information unit for the position of the at least one data carrier. Claim 2 directly depends upon Claim 1 and further limits the scope of Claim 1.

Claim 3 is directed to a method of locating an object provided with a data carrier located in an area. The method comprising: the data carrier receiving position data from a

position-determining system; the data carrier transmitting position data to an information unit; allocating the position data to an area in the information unit; transmitting the boundaries of the area to the data carrier; upon each movement of the data carrier comparing a position of the data carrier with the boundaries of the area; transmitting new position data to the information unit only in the case of a negative result of the comparison of the area boundaries transmitted by the information unit with the position of the data carrier; and interrogating the information unit from a third party for the position of the at least one data carrier. Dependent Claim 4 directly depends upon Claim 3 and further limits the scope of Claim 3.

Each of the appealed claims, mentioned supra, is set forth in the Appendix.

VIII. THE PRIOR ART RELIED UPON

The reference relied upon by the Examiner in rejecting Claims 1-4 is U.S. Patent No. 5,365,451 to Wang et al., (hereinafter "Wang").

X. THE ISSUES

The issue raised in the Final Rejection dated February 11, 2003 remaining for resolution is are Claims 1-4 on appeal patentable, under 35 U.S.C. § 103, over Wang.

X. THE REFERENCES

Wang discloses a mobile unit tracking system having a communication network. The system keeps track of the locations of mobile units that utilize the communication network. On power up of the mobile units, the system determines their current locations using broadcast signals (e.g., from overhead satellites). The mobile units send a data communication to the system to describe their location. The system saves the locations of the mobile units and returns data messages that describe borders that surround the mobile units locations. When the current locations of the mobile units are outside of the prescribed borders, the mobile units send other location data messages to the network to update the location data of the mobile units and receive a definition of a new border.

XI. GROUPING OF THE CLAIMS

The prior art rejections of issue herein apply to more than one claim. Despite this, Appellant submits that the rejected claims stand or fall together.

XII. APPELLANT'S ARGUMENTS

The rejection of Claims 1-4, on appeal, under 35 U.S.C. § 103, as being allegedly unpatentable over Wang is improper.

In the Final Rejection, Claims 1-4 of the instant application were rejected under 35 U.S.C. § 103 as being allegedly unpatentable over Wang.

The basis for the Examiner's rejection is that the Examiner considers the mobile units 16 of Wang to be the data carrier and the gateways 14 of Wang to be the information units and argues that since the gateways 14 have input devices and displays, "a third party can obviously interrogate the information unit ... for the position of the at least one data carrier in order to keep the human workers knowledgeable of events as they occur" (emphasis added).

Firstly, Applicants respectfully submit that Wang neither expressly discloses the input devices being used for interrogating the gateways for the location of the mobile units nor a suggestion of a need for human workers to know of events relating to the locations of the mobile units 16. The Wang patent merely discloses that the location information of the mobile units is used by the system itself (including gateways 14) for purposes of frequency allocation, billing, tax, and for best routing a call through satellites 12. All of these parameters are used internally and automatically in the system of Wang, and thus, there would be no need for human workers to query the gateways 14 for location information of the mobile units 16.

Secondly, the Examiner seems to argue that it would have been obvious to those skilled in the art at the time of the invention for a third party to interrogate the gateways 14 of Wang because such a third party could interrogate the gateways 14 because the gateways were supplied with an input device and a display. However, the Court of Appeals for the Federal Circuit has held that simply because such knowledge "may" have been within the skill of those in the art, such does not "make it so, absent clear and convincing evidence of such knowledge." Smiths Indus. Medical Sys., Inc. v. Vital Signs, Inc., 183 F.3d 1347 (Fed. Cir. 1999).

Thus, Applicants respectfully submit that the Examiner is using impermissible hindsight in combining the Wang reference with the knowledge of an ordinarily skilled artisan in the art at the time of the invention. Thus, their combination to defeat the patentability of the claims is improper. That is, there is no motivation to combine the mobile unit system of Wang with any specific understanding or technological principle within the knowledge of one of ordinary skill in the art regarding the use of input devices to interrogate the gateways for the location of the mobile units.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Furthermore, recently the U.S. Court of Appeals for the Federal Circuit (the "Federal Circuit") restated the legal test applicable to rejections under 35 U.S.C. 103(a) (*In re Rouffet*, 47 USPQ2d 1453 (Fed. Cir., July 15, 1998)). The Court stated:

[V]irtually all [inventions] are combinations of old elements. Therefore an Examiner may often find every element of a claimed invention in the prior art. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an Examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." To prevent the use of hindsight based on the invention to defeat patentability

of the invention, this court requires the Examiner to show a motivation to combine the references that create the case of obviousness. The Board [of Appeals] did not, however, explain what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination. Instead, the Board merely invoked the high level of skill in the field of the art. If such a rote indication could suffice to supply a motivation to combine, the more sophisticated scientific fields would rarely, if ever, experience a patentable technical advance. Instead, in complex scientific fields, the Board could routinely identify the prior art elements in an application, invoke the lofty level of skill, and rest its case for rejection. To counter this potential weakness in the obviousness construct the suggestion to combine requirements stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness.

In re Rouffet, 47 USPQ2d 1457-58 (Fed. Cir., July 15, 1998) (citations omitted, emphasis added).

More recently, the Federal Circuit again dealt with what is required to show a motivation to combine references under 35 U.S.C. 103(a). In this case the court reversed the decision of the Board of appeals stating:

[R]ather than pointing to specific information in Holiday or Shapiro that suggest the combination..., the Board instead described in detail the similarities between the Holiday and Shapiro references and the claimed invention, noting that one reference or the other-in combination with each other... described all of the limitations of the pending claims. Nowhere does the Board particularly identify any suggestion, teaching, or motivation to combine the ... references, nor does the Board make specific-or even inferential-findings concerning the identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or any factual findings that might serve to support a proper obviousness analysis.

In re Dembiczak, 50 USPQ2d 1614, 1618 (Fed. Cir., April 28, 1999) (citations omitted, emphasis added).

Thus, from both *In re Rouffet* and *In re Dembiczak* it is clear that the Federal Circuit requires a specific identification of a suggestion, motivation, or teaching why one of ordinary skill in the art would have been motivated to select the references and combine them or an identification of the level of skill in the art at the time of the invention which would make him likely to combine his skill with the teachings of the art to come up with the invention. This the Examiner has not done. The Examiner merely argues that "a third party can obviously interrogate the information unit ... for the position of the at least one data carrier in order to keep the human workers knowledgeable of events as they occur" (emphasis added).

In the present invention, the query of the location of the mobile units is useful in a variety of applications as discussed in the specification at page 5, line 26 to page 6, line 3. One such application is to locate a person corresponding to one or more of the mobile carriers. When a person's location is to be determined the information unit can be interrogated via a local computer network. Furthermore, a person's or object's movement can be determined to create a "moving map" of the person or object. For example, hauling companies can locate vehicles in an area covered by an

information unit. There is simply no disclosure or suggestion in Wang of a need to locate a person or object or generate a moving map of the same.

As discussed above, the Wang patent merely discloses that the location information of the mobile units is used by the system itself (including gateways) for purposes of frequency allocation, billing, tax, and for best routing a call through satellites. These types of parameters are used internally and automatically in the system of Wang, and thus, there would be no need for human workers to query the gateways for location information of the mobile units.

Thus, Applicants respectfully submit that the Examiner, without identifying the level of skill in the art at the time of the invention, a recognition of the problem addressed by the present invention, or the beneficial results obtained therefrom, has used impermissible hindsight to reject claims 1-4 under 35 U.S.C. § 103(a).

In light of the state of the law as set forth by the Federal Circuit and the Examiner's lack of specificity with regard to the level of skill in the art at the time of the invention, applicants respectfully submit that the rejections for obviousness under 35 U.S.C. 103(a) lack the requisite motivation and must be withdrawn.

Thus, Applicants respectfully submit that:

(1) there is no disclosure in Wang of a third party interrogating the gateways 14 for the location of the mobile units 16, and

(2) the Examiner has used impermissible hindsight to reject claims 1-4 under 35 U.S.C. § 103(a) because there is no suggestion in Wang of a third party interrogating the gateways 14 for the location of the mobile units 16 and the Examiner has not identified the level of skill in the art at the time of the invention by clear and convincing evidence which would lead to such a conclusion. "Rarely, however, will the skill in the art component operate to supply missing knowledge or prior art to reach an obviousness judgment." *Al-Site Corp. v. VSI International Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

With regard to item (1) above, independent claims 1 and 3 are not rendered obvious by Wang because the Wang patent, whether taken alone or in combination with the knowledge of one of ordinary skill in the art, does not teach or suggest a method of locating an object having the features described above.

With regard to item (2) above, in light of the state of the law as set forth by the Federal Circuit and the Examiner's lack of specificity with regard to the level of

skill in the art at the time of the invention, applicants respectfully submit that the rejections for obviousness under 35 U.S.C. 103(a) lack the requisite motivation and must be withdrawn.

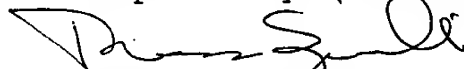
Based on the above arguments and remarks, Appellants respectfully submit that the claims of the instant invention on appeal are not obvious over Wang. Consequently, the rejection of the claims based on the Wang reference is in error.

XIII. CONCLUSION

In view of the remarks submitted hereinabove, the reference applied against Claims 1-4 on appeal do not render those claims unpatentable under 35 U.S.C. § 103. Thus, Appellants submit that the § 103 rejection is in error and must be reversed.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment in connection herewith to Deposit Account No. 19-1013/SSMP. A triplicate copy of this sheet is enclosed.

Respectfully submitted,



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APPENDIX

CLAIMS ON APPEAL: CLAIMS 1-4
Application Serial No. 09/530,253

1. (Amended) A locating system comprising:
at least one data carrier located in an area, the at least one data carrier including a position sensor, a transmitter and a receiver;
an information unit which is remote from the at least one data carrier for storing area information and transmitting the area information to the at least one data carrier;
wherein said at least one data carrier transmits its position to the information unit only in the case of initialization and movement of the at least one data carrier from the area and wherein a third party interrogates the information unit for the position of the at least one data carrier.
2. (Amended) A locating system as claimed in Claim 1, wherein the at least one data carrier has a receiver for receiving area boundaries corresponding to the area, and a memory for storing the area boundaries and absolute position data, and a comparator for comparing the position data with the area information when the transmitter transmits the boundaries of the area to the at least one data carrier.

3. (Amended) A method of locating an object provided with a data carrier located in an area, the method comprising:

the data carrier receiving position data from a position-determining system;

the data carrier transmitting position data to an information unit;

allocating the position data to an area in the information unit;

transmitting the boundaries of the area to the data carrier;

upon each movement of the data carrier comparing a position of the data carrier with the boundaries of the area;

transmitting new position data to the information unit only in the case of a negative result of the comparison of the area boundaries transmitted by the information unit with the position of the data carrier; and

interrogating the information unit from a third party for the position of the at least one data carrier.

4. (Amended) A method as claimed in Claim 3, wherein the position data transmitted by the data carrier is translated into area data in the information unit and the area in which the data carrier is located is stored in the information unit.

5 and 6. (Canceled)